

**II. Rejection Under 35 USC § 102**

Claims 1, 4-7, 15-18, 20, 23, 24, and 26-32 stand rejected under 35 USC § 102(b) as being anticipated by Arraudeau et al. (U.S. Patent No. 4,659,562). Applicant continues to respectfully traverse this rejection for the reasons of record and those that follow.

Independent claims 1, 29, and 30 each recite that "fibers are compatibilized with a fatty phase by at least one polyol." Independent claim 31 relates to, *inter alia*, a method of improving the staying power of a make-up composition containing a fatty phase and at least one polyol that is liquid at room temperature, the method comprising compatibilizing fibers in the composition.

The Examiner states that the disclosure of oils in Arraudeau at column 2, lines 52 through column 3, lines 6-9 "would be envisioned" by one of ordinary skill in the art and therefore is an anticipating disclosure. Office Action at page 6.

Applicant respectfully disagrees. To arrive at Applicant's invention, one would first have to select the combination of a fatty phase and fibers, followed by selecting at least one polyol for compatibilizing the fibers with the fatty phase. Arraudeau provides no such guidance to lead one of ordinary skill in the art to this specific combination. From Arraudeau at column 2, lines 52 through column 3, lines 6-9, one could easily select several options that would not lead to Applicant's claimed invention: (1) an oil that provides a suitable fatty phase without selecting a polyol, (2) a polyol alone without selecting an additional oil that provides a suitable fatty phase, or (3) an oil that does not provide a suitable fatty phase and is not a polyol. Because there are many possible options from the teachings of Arraudeau that would not result in the combination of

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

compatibilizing fibers with a fatty phase by at least one polyol, it is not clear how one of ordinary skill in the art would ultimately arrive at the claimed invention, let alone immediately "envisage" Applicant's invention.

A rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); see also M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."). Importantly, each and every element of a claim must be set forth in the prior art reference for there to be anticipation. See M.P.E.P. § 2131. Because Arraudeau does not teach compatibilizing fibers with a fatty phase by at least one polyol, Arraudeau is not applicable under § 102.

Accordingly, Applicant maintains that Arraudeau et al. fails to disclose any one of: an anhydrous care or make-up composition comprising fibers wherein the fibers are compatibilized with a fatty phase by at least one polyol (claim 1); a lipstick or a lip gloss etc., comprising fibers wherein the fibers are compatibilized with a fatty phase by at least one polyol (claim 29); a cosmetic care or treatment process for human keratin substances comprising fibers wherein the fibers are compatibilized with a fatty phase by at least one polyol (claim 30); or a method for improving the staying power over time and/or a method for improving the gloss of an anhydrous care or make-up composition comprising compatibilizing fibers in the anhydrous care or make-up composition (recited in claim 31).

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

For at least these independent reasons, Applicant submits that none of the pending claims are anticipated by Arraudeau et al. Accordingly, Applicant respectfully requests withdrawal of this rejection.

### III. Rejections under 35 USC § 103

In making a rejection under 35 U.S.C. § 103, the Office has the initial burden to establish a *prima facie* case of obviousness. See, M.P.E.P. § 2143. To meet this burden, there must be some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify or combine reference teachings with a reasonable expectation of success in obtaining the presently claimed invention. See M.P.E.P. § 2143.01; 2143.02.

Merely identifying each of the claimed elements in the prior art is not sufficient to establish a *prima facie* case of obviousness. Evidence of a suggestion or motivation to modify or combine must be "clear and particular." See, *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

#### Arraudeau et al.

Claims 1-7, 15-18, 20, 23, 24, and 26-32 stand rejected under 35 USC § 103(a) as being unpatentable over Arraudeau et al (U.S. Patent No. 4,659,562). Applicant respectfully traverses this rejection.

As discussed in the previous section, Arraudeau does not teach compatibilizing fibers with a fatty phase by at least one polyol. Moreover, Arraudeau's generalized teachings of selecting "at least one oil" does not meet the evidentiary requirement of

"clear and particular" evidence of a suggestion to select the claimed combination of elements. The limitation of compatibilizing fibers with a fatty phase by at least one polyol, in itself involves two concepts. There must be a teaching of (1) compatibilizing fibers with a fatty phase, and (2) the compatibilizing occurs by at least one polyol. The teaching of "at least one oil" does not ultimately lead to this result. Statistically, selecting "at least one oil" more likely leads to a result that does not include (1) the fatty phase, (2) the polyol, or (3) both the fatty phase and polyol. Thus, one of ordinary skill in the art would not achieve Applicant's claimed invention, as there is no clear teaching to select a fatty phase and at least one polyol to compatibilize the fibers. Moreover, the other limitations of the claims must be taught or suggested as well.

The Examiner concedes that Arraudeau is silent on IOB values. According to the Examiner, one of ordinary skill in the art can determine a suitable IOB value by routine experimentation. Office Action at page 3.

Applicant submits that this basis for a rejection is improper because Arraudeau fails to teach the desirability of the recited IOB values. A "particular parameter must first be recognized as a result-effective variable... before determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." MPEP § 2144.05 II.B.; *In re Antonie*. Because Arraudeau is silent on IOB values, Arraudeau fails to show the requisite recognition of IOB values as a result-effective variable. Thus, reliance on a "routine experimentation" basis is not sufficient in where Arraudeau is silent on the result-effective variable.

Accordingly, the Examiner has not established a *prima facie* case of obviousness, and Applicant respectfully requests withdrawal of this rejection.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Arraudeau and Yoshioka

Claims 1-7, 15-18, 20, 23, 24, and 26-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arraudeau et al. in view of Yoshioka (JP 04159218). Applicant respectfully traverses this rejection.

The Examiner concedes that Arraudeau is silent on IOB values and turns to Yoshioka for teaching IOB values. Office Action at page 4.

Arraudeau describes make-up compositions comprising a binding agent and a mixture of silica and polyethylene fibers. Yoshioka describes a gelatin capsule composition comprising gelatin blended with a humectant. There is no suggestion in either Arraudeau or Yoshioka to modify the Arraudeau compositions according to the teachings of Yoshioka. Because there is no motivation to combine Arraudeau with Yoshioka, the combination of references is improper.

Even if the combination were proper, which is not conceded here, Yoshioka fails to remedy Arraudeau's deficiency of failing to teach compatibilizing fibers with a fatty phase by at least one polyol, as Yoshioka does not even teach the use of fibers. Yoshioka also fails to remedy the deficiency of Arraudeau's silence on IOB values. Yoshioka teaches certain IOB values, which are relevant for compositions comprising gelatin and a humectant. There is no teaching, however, of whether these IOB values are relevant to Arraudeau's compositions, which include fibers. Thus, the combination of references fails to suggest the claimed invention.

Accordingly, the Examiner has not established a *prima facie* case of obviousness, and Applicant respectfully requests withdrawal of this rejection.

Arraudeau and Shiseido

Claims 1-7, 15-18, 20, 23, 24, and 26-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arraudeau et al. in view of Shiseido (JP 05320038). Applicant respectfully traverses this rejection.

The Examiner concedes that Arraudeau is silent on IOB values and turns to Shiseido for teaching IOB values. Office Action at page 4.

As discussed above, Arraudeau describes make-up compositions comprising a binding agent and a mixture of silica and polyethylene fibers. Shiseido relates to a composition comprising a polyethylene glycol and certain polyoxy compounds. Shiseido fails to teach the use of fibers. Neither reference suggests how modifying Arraudeau's compositions in accordance with Shiseido's teachings would benefit the compositions of Arraudeau. Because there is no motivation to combine Arraudeau with Shiseido, this combination of references is improper.

Even if the combination were proper, which is not conceded here, Yoshioka fails to remedy Arraudeau's deficiency of failing to teach compatibilizing fibers with a fatty phase by at least one polyol. Shiseido fails to teach the use of fibers, much less, compatibilizing fibers in a fatty phase with at least one polyol. Moreover, the IOB values taught by Shiseido are useful for compositions comprising polyethylene glycol and polyoxy. There is no teaching in Shiseido whether these IOB values would benefit the compositions of Arraudeau. Thus, the combination of references fails to suggest the claimed invention.

Accordingly, the Examiner has not established a *prima facie* case of obviousness, and Applicant respectfully requests withdrawal of this rejection.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Arraudeau and Franzke

Claims 1 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arraudeau et al. and Franzke et al. (U.S. Patent No. 5,965,146). Applicant respectfully traverses this rejection.

The Examiner concedes that Arraudeau does not teach the fibers recited in present claim 14 and turns to Franzke for teaching polyamide fibers. Office Action at page 5.

Franzke relates to aqueous or aqueous/alcoholic cosmetic compositions comprising a hair fixing or thickening polymer and polyamide or silk fibers. Franzke, however, fails to remedy Arraudeau's deficiency of failing to teach compatibilizing fibers with a fatty phase by at least one polyol. Franzke does not teach the use of a fatty phase, as Franzke teaches only aqueous or aqueous/alcoholic compositions. In particular, there is no suggestion in Franzke to modify the compositions of Arraudeau to include at least one polyol for compatibilizing fibers in a fatty phase. Thus, the combination of references fails to suggest the claimed invention.

Accordingly, the Examiner has not established a *prima facie* case of obviousness, and Applicant respectfully requests withdrawal of this rejection.

Arraudeau and Bara

Claims 14-22 and 25-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arraudeau et al., in view of Bara et al. (U.S. Patent No. 6,177,091). Applicant respectfully traverses this rejection.

The Examiner concedes that Arraudeau does not teach parlean oil and turns to Bara for teaching such oils. Office Action at page 5.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Bara is directed to a composition comprising an organopolysiloxane and a fatty phase comprising at least one non-volatile oil and at least one wax. Bara fails to teach the use of fibers.

Applicant continues to maintain that those of ordinary skill in the art having knowledge of Arraudeau's composition comprising fibers would not find it obvious to substitute Arraudeau's composition base with the base of the composition of Bara et al. and to compatibilize Arraudeau's fibers in the Bara base, due to a lack of clear teaching or suggestion in the references, as set forth by Applicant's remarks of record.

Thus, the Examiner has not established a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests withdrawal of this rejection.

#### IV. Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: July 8, 2002

By: 

Lori-Anne Johnson  
Reg. No. 34,498

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com